UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,280	01/23/2002	Narayan L. Gehlot	GEHLOT 32-39 (375824/0163	6768

30541 7590 03/21/2006

LAW OFFICE OF JOHN LIGON
213 E. HIGHLAND AVENUE
P.O. BOX 281
ATLANTIC HIGHLANDS, NJ 07716

EXAMINER	
LE, DEBBIE M	

ART UNIT	PAPER NUMBER
2168	

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/055,280	GEHLOT ET AL.	
	Examiner	Art Unit	
	DEBBIE M. LE	2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 December 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicants' arguments filed on 12/29/05. Claims 1-31 are pending for examinations.

The double patenting rejections to claims 1-31, with respect to a terminal disclaimer filed by Applicants on 12/29/05 has been acknowledged and therefore, the double patenting rejection of these claims has been withdrawn.

The rejection to claims 2-12 as an improper antecedent has been withdrawn with respect to Applicants' amended to claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The analysis under 35 U.S.C 112, first paragraph, requires that the scope of protection sought be supported by the specification disclosure. The pertinent inquiries including determining (1) whether the specification disclosure as a whole is to enable one skilled in the art to make and use the claimed invention.

Claims 1, 13, 14, 25 and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claims 1, 13, 14, 25 and 26 recite "*contemporaneously with movement of the object*". The limitation "*contemporaneously with movement of the object*", contains conflicting or mutually exclusive limitation when being considered with the disclosure of specification because the instant application disclosure states that "By having the personal data move, **at a time independent of the movement of the monitored person,** from a first location to a second location" and "if the user moves at a time of peak communication traffic, **the personal data** may by **moved either** before **or** after **the user" (see specification page 3, lines 15-22)**. Thus, the invention establishes a *contemporaneously* which appears to be inconsistent with the disclosures of the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-10, 12-17, 19-22, 24-26, 28-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Penttonen (US Patent 5,627,877).

As per claim 1, Penttonen a dynamic database system comprising:

a first data storage unit disposed proximate a first position and adapted to store object data related to an object (as VMS1 stores information related to subscribers) (see col. 2, line 67, col. 3, lines 2-4);

a second data storage unit disposed proximate a second position and adapted to store said object data (as VMS2, VMS3, stores information related to subscribers) (see col. 2, line 67, col. 3, lines 2-4); and

a processing unit adapted to process position data related to the object in response to movement of the object between the first position and the second position (col. 3, lines 15-16), and operative to cause said object data to be transferred from said first data storage unit to said second data storage unit contemporaneously with the movement of the object moves from the first position to the second position (col. 3, lines 17-21, 45-46).

As per claim 2, Penttonen teaches wherein when the object moves from the first position to the second position during a high communication traffic period, said object data is delayed so as to be transferred from said first data storage unit to said second data storage unit during a low communication traffic period (col. 3, lines 45-49).

As per claim 3, Penttonen teaches wherein said object data is transferred as a function of a predicted movement of the object before the object moves (col. 3, lines 25-26).

As per claim 4, Penttonen teaches wherein said predicted movement is based upon travel information chosen from the group consisting of airline reservations, car rental reservations, hotel reservations and the object's travel history (col. 3, line 16).

As per claim 6, Penttonen teaches a first communication unit coupled to said first data storage unit; and a second communication unit coupled to said second data storage unit (Fig. 1, MSC1-3, col. 2, lines 25-26) wherein said data is transferred from said first data storage unit to said second data storage unit via said first communication unit and said second communication unit (Fig. 1, VMS1-3).

As per claim 7, Penttonen teaches wherein said first communication unit and said second communication unit communicate wirelessly (as mobile communication network, col. 2, lines 54-55).

As per claims 8-9, Penttonen teaches a personal communication unit coupled to said processing unit and adapted to facilitate communication of said object data between the object and said first and said second data storage units, to facilitate communication of said travel information between the object and said first and said second data storage units (col. 3, lines 5-7, 15-16).

As per claim 10, Penttonen teaches wherein when the object returns to said first position from said second position, the object data is transferred from said second data storage unit back to said first data storage unit at a time other than the time when the object returns (col. 1, line 58, col. 2, lines 23-26).

As per claim 12, Penttonen teaches wherein the object is a person and said object data is chosen from the group consisting of medical information, financial

information, driver record information, personal contact information and insurance information (col. 1, lines 65-67, col. 3, lines 30-34).

Claims 13, 14, 25 and 26 are rejected by the same rationale as state in independent claim 1 arguments.

Claims 15-17, 19-22, 24, 28-31 have similar limitations as claims 2-4, 6-10, and 12; therefore, they are rejected under the same subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 5, 18 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Penttonen (US Patent 5,627,877) as applied to claims 1, 14, and 26 above, and further in view of Howard (US Patent 6,614,392 B2).

As per claim 5, Penttonen does not explicitly teach a global positioning system (GPS) unit coupled to said processing unit and adapted to obtain said position data related to the object. However Howard discloses a global positioning system (GPS) unit coupled to said processing unit and adapted to obtain said position data related to the object (see abstract). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references to implement a global positioning system (GPS) unit coupled to said processing unit and adapted to obtain said position data related to the object as taught by Howard because it would enable the object to be tracked and identified as it moves from one point to another point, as suggested by Howard (see abstract).

Claims 18 and 27 have similar limitations as claim 5; therefore, they are rejected by the same subject matter.

Claims 11 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Penttonen (US Patent 5,627,877) as applied to claims 1 and 14 above, and further in view of Kullick et al (US Patent 5,751,997).

As per claim 11, Penttonen discloses the automatic relocation of the subscriber's home station in connection with a new switching central to reduce the demand of the costs of a mobile network. Penttonen does not explicitly teach wherein the object data is deleted from said second storage unit when the object data is transferred from said

second data storage unit back to said first data storage unit. However, Kullick discloses the object data is deleted from said second storage unit when the object data is transferred from said second data storage unit back to said first data storage unit (col. 11, lines 3-7). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references to implement the step of deleting the transferred data from the transfer storage when the transferred data is completely transferred to its destination as taught by Kullick because it would allow Penttonen's system to avoid disk size of a storage device overloaded so that amount of memory (disk size of a storage device) always become available (see Kullick, col. 4, lines 12-13, col. 7, lines 14-19, col. 10, lines 45-46) in order to allow Penttonen's system automatic transferring the subscriber-related information in a dynamic relocating subscriber's information without concerning "unavailable memory".

Claim 23 have similar limitations as claim 11; therefore, it is rejected by the same subject matter.

Response to Arguments

Applicant's arguments filed 12/29/05 have been fully considered but they are not persuasive.

First Applicant argues that Penttonen does not teach where the database itself is transferred from a first to a second location because Penttonen's invention only for maintaining a continuously changing data base is transferred.

In response, the Examiner respectfully disagrees. First, the recited claims claim that "a first data storage unit" to "store object data related to an object", "in response to movement of the object", "said object data to be transferred from said first storage unit to said second storage unit". As seen, the database itself as argues by Applicant (as a data storage), which in turn as the database contains data related to an object (as object data related to an object). "in response to movement of the object", from the first position to a second position, "said object data to be transferred from said first data storage unit to said second data storage unit". This limitation does nothing than is just transferring the data belongs to the object when the object moves from location to other location as read on Penttonen a subscriber moves, e.g., to another city, into the area of another MSC, information about movements of the subscriber concluding that the subscriber has moved, a transfer of subscribers' information to the new VMS (col. 3, lines 15-21, 30-34). Thus, Penttonen does teach the claim invention "object data to be

transferred from said first data storage unit to said second data storage unit in response to movement of the object".

Second, Applicant argues that the amended claims recite limitation directed to the data transfer occurring contemporaneously with movement of the object.

In response, the examiner respectfully submits that this new limitation fails to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, has possession of the claimed invention. In claims 1, 13, 14, 25 and 26 recite "*contemporaneously with movement of the object*". The limitation "*contemporaneously with movement of the object*", contains conflicting or mutually exclusive limitation when being considered with the disclosure of specification because the instant application disclosure states that "By having the personal data move, **at a time independent of the movement of the monitored person,** from a first location to a second location" and "if the user moves at a time of peak communication traffic, **the personal data** may by **moved either** before **or** after **the user" (see specification page 3, lines 15-22)**. Thus, the invention establishes a *contemporaneously with movement of the object* which appears to be inconsistent with the disclosures of the specification.

The Examiner thanks you to Applicants to describe the instant application invention for the purpose of using dynamic database "not only involve intensive use of long-haul communication facilities, but also an increased likelihood of error being introduced by multiple communication hops" (as supported in the specification, page 17,

lines 3-13). However, it notes that the limitations from the specification are not read into the claims. *See In re Van Geuns,* 988 F.2d 1181, 26 USPQ2d 1057 (Feb. Cir. 1993).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBBIE M. LE whose telephone number is (571) 272-4111. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JEFFREY GAFFIN can be reached on (571) 272-4146. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DEBBIE LE
PRIMARY EXAMINER
3/15/06